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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bernard Agasse

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12/29/2005

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EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/744,215

Applicant(s)

AGASSE, BERNARD

Examiner

Son P. Huynh

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2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005 and 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15 and 31-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 31-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/12/2005 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 07/13/2005 have been fully considered but they are not persuasive.

Applicant argues either Lajoie or Marshall discloses display only the selected menu item of a service with the submenu and minimal interference with underlying program (page 8, paragraph 2 and bridge paragraph between page 8 and page 9).

In response, this argument is respectfully traversed. Lajoie discloses the interactive program guide has any of at least three main modes: a time mode, a theme mode, and

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a title mode. The theme mode displays program information on programs which were, are, or will be available for viewing based upon a user selected theme category. Once the theme category has been selected, all programs within that theme are displayed to the user (col. 6, lines 15-46). Thus, the claimed feature of “display only the menu item corresponding to the selected one of the listed services” is met by display only programs corresponding to the user selected theme category.

Marshall discloses superimposing only portions of a scroll program guide over a basic programming signal for displaying on the viewer's display screen (see abstract, lines 1-4). Marshall further discloses the level of transparency is selected by the user (e.g. 100 %, 90%, 80 %, and so on – col. 3, lines 40-45). Therefore, the claimed feature of “wherein interference with the program is minimal” is broadly read on a portion of basic program is being viewed on the display (either on the remain portion of the screen or transparency).

For the reasons given above, rejection on claims 15 and 31-53 are analyzed as discussed below.

Claims 1-14, 16-30 have been canceled.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15 and 31-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,772,433 to LaJoie et al. in view of U.S. Patent No. 5,828,420 to Marshall et al.

Regarding Claim 15, LaJoie discloses a method for providing a user with options for accessing at least one of a plurality of received channels (See Figure 16) comprising at least one channel (390) and a service channel (Col. 16, Lines 12-33) of a digital television system (See Figure 1) comprising the steps of generating a service menu for display on a display (See Figure 16), the service menu comprising a list of menu items corresponding to a plurality of services available to a user (i.e. theme categories, titles, channels of programming available). Further disclosure is generating, upon selection of one of the listed services from the service menu (i.e. selecting theme/an IPPV channel from the EPG), at least one subsidiary menu (particular themes category) for display on the display with only the menu item corresponding to the selected service (all programs within the selected theme) to provide the user with a plurality of options for accessing at least one of the received channels (Col. 6, lines 15-46; col. 31, Lines 15-25). What is

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not disclosed, however, is that the menus are superimposed over a program transmitted on one of the received channels, wherein interference with the program is minimal.

Marshall discloses an electronic program guide wherein the menus are superimposed over the information transmitted on a video channel (See abstract, lines 1-4; Figures 3-9) wherein the level of transparency is selectable by the user (Col. 3, Lines 40-45). Marshall further discloses the program guide superimposed only portions of basic programming signal (see abstract, lines 1-4) or level of transparency is 100% (col. 3, lines 40-45) broadly reads on wherein interference with the program is minimal (since use still see the basic program). Marshall is evidence that ordinary workers in the art would recognize the benefits of superimposing an EPG on video programming in a digital television system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of LaJoie with the EPG superimposed on the video programming of Marshall in order to allow the user to continue viewing the program in a full screen with only minimal, user-definable intrusion by the EPG menu.

Regarding Claim 31, LaJoie in view of Marshall disclose a method as stated above in Claim 15. What is not disclosed, however, is that the list of services contained in the menu is varied according to the subscription rights of the user. Official Notice is hereby taken that it is well known in the art to implement conditional access to services in a digital television system. This reads on the claimed list of services being variable depending on the subscription rights of the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the

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method of LaJoie in view of Marshall with the conditional access of the well-known prior art in order to implement multiple tiers of access based on different levels of purchased services or to parentally restrict children from accessing various services, for example.

Regarding Claim 32, LaJoie in view of Marshall disclose a method as stated above in Claim 15. LaJoie further discloses allowing a user to sort the list of services (EPG) by user preference (See Figures 20-23 and Col. 26, Line 42 – Col. 27, Line 32 and Col. 28, Lines 11-53). This reads on the claimed list of services contained in the menu being ordered according to the preferences of the user.

Regarding Claim 33, LaJoie in view of Marshall disclose a method as stated above in Claim 15. LaJoie further discloses that control signals are received from a remote control handset (Col. 15, Lines 3-6).

Regarding Claim 34, LaJoie in view of Marshall disclose a method as stated above in Claim 33. LaJoie further discloses that the service menu is generated for display on the display in response to the touch of a single dedicated key on the handset (Col. 26, Lines 11-13).

Regarding Claim 35, LaJoie in view of Marshall disclose a method as stated above in Claim 33. LaJoie further discloses that the display of the list of services contained in the

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menu is scrolled in response to commands received from navigation keys of the handset (Col. 25, Lines 3-10).

Regarding Claim 36, LaJoie in view of Marshall disclose a method as stated above in Claim 15. LaJoie further discloses that the service menu is scrolled within a fixed framework such that the cursor and grid do not move (Col. 24, Line 66 – Col. 25, Line 3). This reads on the claimed service menu being scrolled around a fixed bar displayed on the display.

Regarding Claim 37, LaJoie in view of Marshall disclose a method as stated above in Claim 36. LaJoie further discloses that the fixed bar (cursor and grid framework of the EPG) include navigations arrows showing possible directions of movement of the service menu (See Figure 16, 352, 354, 356 and 358).

Regarding Claim 38, LaJoie in view of Marshall disclose a method as stated above in Claim 15. LaJoie further discloses that upon user selection of one of the options from the subsidiary menu (for example, pressing the buy option of Figure 28), a second subsidiary menu is generated for display on the display with the selected one of the listed services (552) to provide the user with a plurality of further options (554, PIN Entry or Cancel) for accessing at least one of the received channels (Col. 31, Lines 15-36).



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Regarding Claim 39, LaJoie in view of Marshall disclose a method as stated above in Claim 15. LaJoie further discloses that the channel displayed on the display is changed in response to the selection of a particular option from a subsidiary menu (Col. 31, Lines 33-36).

Regarding Claim 40, LaJoie in view of Marshall disclose a method as stated above in Claim 39. LaJoie further discloses that the set top box tunes to a channel to immediately display an IPPV event in response to the user's selection from the subsidiary menu as stated above. This reads on the claimed service channel from the received channels (IPPV channel) being accessed at a particular display screen (wherever the IPPV event is in progress) within that service channel in dependence on the option chosen within a subsidiary menu.

Regarding Claim 41, LaJoie in view of Marshall disclose a method as stated above in Claim 15. LaJoie further discloses that the menus contain regularly updated information received together with the program over which the menus are superimposed (Col. 30, Lines 55-58).

Regarding Claim 42, see Claim 15 above. LaJoie further discloses a decoder (See Figure 3, 38) for receiving the channels and a control unit (30, 36) for generating the menus.

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Regarding Claims 43-53, see Claims 31-41 above, respectively.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Otsuki et al. (US 5,929,932) discloses displaying, upon user selection of the listed services (sports, movies, etc.) from the service menu, at least one subsidiary menu (i.e. Sports guide) for display on the displayed superimposing over the program (i.e. program 2) together with only the menu item (program 1, program 8, etc.) corresponding to the selected one of the listed services to provide the user with a plurality of portions for accessing at least one of the received channels, wherein interference with the program is minimal (figures 3, 4, 8-9).

Smith (US 5,933,141) discloses mutatably transparent displays.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 571-272-7294. The fax phone


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SPH

December 14, 2005



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SUPERVISORY PATENT EXAMINER  
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